LIBRARY
SUPREME COURT

NO. 847

Office-Supreme Court, U.S.
FILED
MAR 18 1964
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

SETRAK K. BOYAJIAN, individually
and doing business as
PRECISION TESTING LABORATORIES,
Petitioner,

v.

OLD COLONY ENVELOPE CO., INC.
and STEIN HALL & CO., INC.,
Respondents.

ON PETITION FOR WRIT OF CERTIORARI TO
THE UNITED STATES COURT OF APPEALS FOR
THE FIRST CIRCUIT

BRIEF FOR RESPONDENTS IN OPPOSITION

EBEN M. GRAVES
Counsel for Respondents
90 Broad Street
New York, New York, 10004

March 19, 1964.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

No. 847

SETRAK K. BOYAJIAN, individually
and doing business as
PRECISION TESTING LABORATORIES,
Petitioner,

v.

OLD COLONY ENVELOPE CO., INC.
and STEIN HALL & CO., INC.,
Respondents.

ON PETITION FOR WRIT OF CERTIORARI TO
THE UNITED STATES COURT OF APPEALS FOR
THE FIRST CIRCUIT

BRIEF FOR RESPONDENTS IN OPPOSITION

OPINIONS BELOW

The *per curiam* opinion of the Court of Appeals for the First Circuit (App. B to Petition) in the matter *sub judice* is reported at 323 Fed. 2d 871. It affirms a judgment of the United States District Court for the District of Massachusetts, entered on Respondents' motion for summary judgment, adjudging that Respondents do not and have not infringed Petitioner's patent (R.* 82-83). The

*Pursuant to this Court's Rule 21(4), the record here comprises four record appendices printed for use of the court below. Said appendices, as designated by Petitioner and as cited in this Brief, are as follows:

"R."—Petitioner's appendix on Appeal No. 6120 below.
"RA."—Petitioner's appendix on Appeal No. 5598 below.
"X."—Respondents' appendix on Appeal No. 6120 below.
"Y."—Respondents' appendix on Appeal No. 5598 below.

opinion of the District Court is reported at 233 Fed. Supp. 905 (R. 79-82, 84-86).

STATEMENT OF THE CASE

This action was commenced by Respondent Old Colony Envelope Company, Inc.'s petition, filed December 30, 1957, for a declaratory judgment that Petitioner's Patent No. 2,804,395 is invalid and not infringed by Respondents' products (RA. 7-11). Petitioner counterclaimed separately against each Respondent, charging Old Colony with direct infringement (RA. 12, 14) and Respondent Stein Hall & Co., Inc., with contributing to the infringement of his patent (RA. 20-21). Respondents replied within the time provided (RA. 13, 22-23).

Subject Matter

Petitioner's patent (RA. 97-101) claims envelope seal flaps and similar paper articles coated with a remoistenable adhesive, the essential ingredient of which is polyvinyl alcohol which has been chemically and physically modified by having been boiled in aqueous solution for approximately an hour.*

The alleged direct infringements of Petitioner's patent are the envelopes made by Old Colony which have seal

---

*An illustrative claim, Claim 4, provides:

> An envelope having on the underside of the marginal portions of the seal flap thereof a glossy layer of remoistenable adhesive coating composition having as its essential ingredient polyvinyl alcohol which has been boiled in aqueous solution by dissolving in hot water in a suitable jacketed kettle having a mixer and bringing the temperature to boiling and keeping it there under agitation for approximately one hour or until all the lumps have disappeared, and a near-clear, homogeneous solution has been formed, with all volatile contaminants distilled off therefrom (RA. 100).

flaps coated with a remoistenable adhesive composition made by Stein Hall and identified by the trademark SUPERSEAL (X. 371a-372a). Stein Hall's SUPERSEAL adhesive composition contains a minor proportion of polyvinyl alcohol (Y. 143a). The Courts below have found that Stein Hall, in making its SUPERSEAL adhesive, does not at any time boil the polyvinyl alcohol ingredient, 223 F. Supp. 905, 906 (R. 79-82, 84-86).

Polyvinyl Alcohol Adhesives

Polyvinyl alcohol is a powder, not a liquid. It has been available for many years as a staple, commercial chemical (Pl. Ex. 5, Y. 179a; RA. 43). Certain grades of polyvinyl alcohol are specially suited for use as remoistenable adhesives (Pl. Ex. 2; Y. 183). They are applied to the paper in water solution to form the familiar "lick and stick" type adhesive used on envelope seal flaps (X. 369a-370a).

Petitioner was not the first to use polyvinyl alcohol as a remoistenable adhesive. In 1944, nine years before Petitioner filed the application for his patent, The Western Union Telegraph Company obtained a patent (Pl. Ex. 6; RA. 103-108) claiming the use of polyvinyl alcohol as a remoistenable adhesive for telegraph tape, envelopes, postage stamps, etc. In 1947, DuPont, a major producer of polyvinyl alcohol, published a 44 page brochure which described in detail, methods to facilitate the preparation of aqueous solution of polyvinyl alcohol for use as remoistenable adhesives for many products, including envelopes (Pl. Ex. 2; Y. 184a-185a). The DuPont brochure states that polyvinyl alcohol may be quickly and effectively dissolved by stirring it vigorously in water heated to about 190 degrees Fahrenheit (*Id.* at 184a).

On the basis of DuPont's disclosures primarily, the Courts below have found that the invention, if any, of

Petitioner's patent must reside in the additional step of boiling the polyvinyl alcohol solution, under agitation, for about an hour to chemically and physically modify the polyvinyl alcohol, 279 F. 2d 572, 574-575; 176 F. Supp. 627, 629; 223 F. Supp. 905, 905-906. Aqueous solutions of polyvinyl alcohol boil at 212 degrees Fahrenheit (X. 197a-201a).

The Proceedings Below

This action has been adjudicated below on Respondents' second motion for summary judgment.

Respondents' first motion for summary judgment, filed July 10, 1959, in the District Court, sought adjudication that (a) the claims of Petitioner's patent are invalid and (b) that Respondents' products do not infringe any such claims (RA. 61-62). In support of the motion, Respondents submitted extensive discovery depositions, affidavits, and numerous documentary exhibits (RA. 79-81, 97-108; Y. 116a-153a, 168a-186a; X. 197a-203a, 322a-510a). On September 16, 1959, the District Court, finding no genuine issue of material fact, granted summary judgment that all ten claims of Petitioner's patent were invalid for lack of invention because the boiling step, the sole point of novelty of Petitioner's alleged invention, is merely an obvious variation of DuPont's methods for facilitating the dissolution of polyvinyl alcohol, 176 F. Supp. 627, 630 (RA. 63-68). The District Court's Decree contained no findings as to infringement, holding the issue moot in view of the adjudication of invalidity (RA. 68-69).

On appeal, Petitioner's first appeal in this case, the Court of Appeals entered judgment on June 14, 1960, reversing and vacating the District Court's judgment of invalidity of Petitioner's patent (X. 512a). The Court of Appeals did not decide that Petitioner's patent is valid. It held only that Respondents' record on the motion did not

fully support the District Court's finding that boiling aqueous solutions of polyvinyl alcohol is an obvious variation of DuPont's methods of preparing aqueous solutions of polyvinyl alcohol for use in remoistenable adhesives, 279 F. 2d 572, 575-576 (R. 15-21). Neither Respondents nor Petitioner sought this Court's review of such June 14, 1960, judgment of the Court of Appeals.

Following remand, Respondents supplemented their record with additional affidavits and corroborating documentary evidence (R. 41-42; X. 204a-321a), and then moved the District Court for summary judgment that their products did not infringe Petitioner's patent, directly or contributorily (R. 40-41). Respondents' record on such motion fully disclosed all the details of Stein Hall's production of its SUPERSEAL adhesive. That unrefuted evidence showed that, beginning three years before Petitioner's patent issued and continuing without change through October 1962, Stein Hall dissolved the polyvinyl alcohol ingredient of its SUPERSEAL adhesives in accordance with DuPont's instructions, by stirring it vigorously for one half hour in water heated to about 190 degrees Fahrenheit, which is twenty-two degrees below boiling, 212 degrees Fahrenheit (X. 204a-367a).

On the record thus made, the District Court on February 5, 1963, granted Respondent's second motion for summary judgment, finding that the polyvinyl alcohol ingredient of Respondent's SUPERSEAL adhesive is not boiled, but is merely dissolved in water maintained at about 190 degrees Fahrenheit, 223 F. Supp. 905, 907 (R. 79-82). On February 6, 1963, the District Court entered its amended judgment that Respondents do not infringe Petitioner's patent (R. 82-83). On Petitioner's motion to amend the opinion of February 5, 1963, the District Court entered a supplemental opinion holding that Petitioner's

unsupported and speculative arguments did not create any genuine issue of material fact precluding the grant of summary judgment, 223 F. Supp. 905, 907 (R. 84-86).

On appeal, the Court of Appeals entered judgment (App. A to Petition) on November 5, 1963, affirming the District Court's amended judgment. Petitioner's timely petition for rehearing was denied by the Court of Appeals on November 26, 1963 (App. C to Petition). The Petition to this Court followed.

ARGUMENT

THIS CASE DOES NOT PRESENT ANY QUESTION OF PUBLIC INTEREST OR INVOLVE ANY MATTER DESERVING REVIEW BY THIS COURT.

This is an ordinary patent case, decided on basic principles of patent law. Its only unusual feature is that it has been prosecuted *pro se* by Petitioner.

The decisions below and the record here reflect the thorough and patient consideration accorded Petitioner's evidence and contentions by the District Court and the Court of Appeals. Those courts, in concurring opinions, have found on specific, unrefuted facts that Petitioner's patent was not and is not infringed by Respondents.

The summary judgment of non-infringement is clearly correct, fully supported by the record, and fully in accord with proper and established practice under Rule 56 of the Federal Rules of Civil Procedure. There are no special or important reasons for this court to review the decision below.

CONCLUSION

The Petition for Writ of Certiorari should be denied.

Respectfully submitted,

EBEN M. GRAVES
Counsel for Respondents

March 19, 1964